



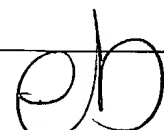
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,551	12/12/2001	Jean-Pierre Pascault	CV-31583	2290
22202	7590	07/26/2004	EXAMINER	
WHYTE HIRSCHBOECK DUDEK S C			TESKIN, FRED M	
555 EAST WELLS STREET			ART UNIT	
SUITE 1900			PAPER NUMBER	
MILWAUKEE, WI 53202			1713	

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/937,551	Applicant(s) PASCAULT ET AL.	
	Examiner Fred M Teskin	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The Amendment of June 29, 2004 has been entered with the following effect:

- (i) the rejection under 35 U.S.C. 112, second paragraph, has been mooted by the amendment to claim 1 deleting reference to "Cardura E10 (meth)acrylate"; and
- (ii) the prior art rejection based on GB '048 (Ricoh) is withdrawn in view of applicants' representation that the general definition of allylic (meth)acrylate is not limited to the (meth)acrylate of allylic alcohol but to any (meth)acrylate additionally containing an allylic end group and that, therefore, the monomers cited in Examples 2-4 of Ricoh are excluded from component B, as defined, by the language of claim 1 stipulating "the monomer or oligomer being other than an allylic (meth)acrylate".

The finality of the previous Office action is hereby **withdrawn** so that new issues relating to obviousness-type double patenting and indefiniteness may be raised with respect to claims 1-28, as detailed below.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,586,097. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ merely in matters of scope and/or semantics. In particular, both the rejected and patented claims are drawn to crosslinked microparticles of between 10 and 300 nm in size, obtained by polymerization of a composition of ethylenically unsaturated polymerizable compounds, wherein the composition can comprise identical species of ethylenically unsaturated monomers. Thus the patented claims are readable on polymerizing at least one monomer A, at least one monomer B and at least one compound D, as defined in patent claim 1. The monomer B and the compound D are seen to correspond respectively to applicants' component B and C as claimed herein, while the monomer A substantially overlaps in scope with applicants' component A; e.g., both may be selected from isobornyl (meth)acrylate, cyclohexyl (meth)acrylate and norbornyl (meth)acrylate. (*Cf.*, claim 1 and patent claims 1, 3 and 4.) Furthermore, in both the instant and patented inventions, the crosslinked microparticles are obtained (or prepared) by essentially the same dispersion polymerization procedure. (*Cf.*, claim 8 and patent claims 1 (lines 2-4) and 17.)

Accordingly, no patentable distinction is discernible between the applicants' invention as claimed and the invention claimed in the cited patent.

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Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the following grounds for indefiniteness apply to the indicated claims.

Claims 1 and 5 are indefinite due to an error in nomenclature: "norbonyl" is incorrect and apparently should read –norbornyl- (*cf.*, page 5, line 3 of the specification).

Claim 5 also is indefinite as inconsistent with the base claim as regards the composition of component A. Note the recitation in claim 5 of "butyl (meth)acrylate" as an *individual* species of component A, whereas claim 1 is limited to a C₂–C₈ alkyl (meth)acrylate *in combination with* one or more of isobornyl (meth)acrylate, norbornyl (meth)acrylate and cyclohexyl (meth)acrylate. See the definition of component A in claim 1, which does not allow for selection of butyl (meth) acrylate *per se* as said component.

Claims 5, 16 and 17 are rendered indefinite by the recitation of a broad range or limitation followed by the linking term "preferably" (5 and 16) or "more particularly" (17) and a narrower range or limitation that falls within the broad range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

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In the present instance, claim 5 recites the broad recitation "dimethacrylates of: ethylene glycol, propylene glycol ... diol oligomers with an Mn of less than 2500", and the claim also recites "preferably polyethers, ... polyurethanes", which is a narrower statement of the range/limitation. Similarly, claim 16 recites the broad range of "0.5 to 50 %" and the claim also recites the narrower range of "preferably from 5 to 30 %", while claim 17 recites the genus "polyolefins" and the claim also recites "more particularly polyethylene, ... and ethylene/propylene copolymers", which is a narrower statement of species within the genus.

Claim 7 is indefinite as the language "possibly partially modified" makes it unclear as to if and when the stated modification occurs. If conditional language is necessary, then it is suggested that the language "optionally" be substituted; otherwise positive language should be used.

Claims 6 and 17 are indefinite due to improper Markush language in the recitations "carboxylic acid salt *or* combinations thereof" and "polyester *or* polyamide fibres", respectively. Either "selected from the group consisting of ... ***and*** ..." or "wherein [f1 or the polar substrates] is/are ... ***or*** ..." is proper; see MPEP 2173.05(h).

Claim 25 is confusing and technically inaccurate in listing "vinyl esters", a common type of monomer, in a Markush group directed to "reactive resin" (see lines 2-3); presumably the (co)polymer thereof was intended. Clarification and appropriate correction are required.

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The disclosure is objected to because of the following informalities: at page 4, line 6, the term "norbonyl" is incorrect and apparently should read –norbornyl- (*cf.*, page 5, line 3).

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the lack of proper antecedent basis for the subject matter of the phrase "the monomer or oligomer being other than an allylic(meth)acrylate", as recited in claim 1, lines 9-10.

In view of the new grounds of rejection presented above, this action is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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FRED TESKIN
PRIMARY EXAMINER
1713

FMTeskin/07-20-04